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REMARKS

The present communication is intended to be fully responsive to all points of objection and/or rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application is respectfully requested.

Applicant asserts that the present invention is new, non-obvious and useful. Prompt consideration and allowance of the claims is respectfully requested.

Status of Claims

Claims 1-50 and 53-60 are pending in the application. Claims 1-50 and 53-60 have been rejected.

Claim Rejections

35 U.S.C. § 103 Rejections

In the Office Action, the Examiner rejected claims 1-4, 7-9, 11-16, 18-19, 21, 24-30, 53-55, 57-60 under 35 U.S.C. § 103(a), as being unpatentable over Cruickshank (US PAT: 6,704,294, filed 10-13-1999) in view of Thomson et al. (US 2001/0056466A1, filed 12-19-2000). Applicant respectfully traverses these rejections because the Examiner failed to establish a prima facie case of obviousness – more specifically: (1) the Examiner did not establish the motivation to combine the primary and secondary reference, and (2) even if the combination was proper, the combined teachings of the two references do not teach all the limitations of the independent claims.

Independent claim claim1 recites:

"A method comprising: accepting information regarding an audio communication session among a set of audio communication terminals, *wherein each of a subset of the audio communication terminals is associated with a data collaboration terminal; and initiating a data collaboration session for an associated data collaboration terminal, using an audio communication terminal.*"

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Independent claim 25 recites:

"A method comprising: receiving information regarding an audio session among a plurality of audio communication devices; for each audio communication device, determining which, if any, of a set of data collaboration terminals are associated with the audio communication device; *and initiating a data collaboration session among the data collaboration terminals associated with the audio communication devices, using an audio communication terminal.*"

Independent claim 53 recites:

"A device comprising: a controller to accept information regarding an audio communication session among a set of audio communication terminals, wherein each of a subset of the *audio communication terminals is associated with a data collaboration terminal; and to initiate a data collaboration session for an associated data collaboration terminal, using an audio communication terminal.*

Whereas, the primary reference, Cruickshank, teaches:

"Parallel data network and telephone network communications are established to facilitate a collaboration combining the data transfer and document sharing strengths of a data network with the superior audio communication of a telephone network. The method involves receiving an identifier of a calling station and called station, determining the IP addresses of computers associated with the calling station and called station, and causing the computers of the called and calling stations to establish a data-only collaboration. In an alternative embodiment, the method additionally involves determining the CLIDs associated with the calling and called stations, and connecting the telephones of the called and calling stations." (Abstract of Cruickshank).

Whereas according to claims 1, 25 and 53 " *the audio communication terminals is associated with a data collaboration terminal*", contrary to what is claimed in claim 1, the Cruickshank reference teaches using two parallel networks, an audio and a telephone network. Whereas according to claims 1, 25 and 53, *initiating a data collaboration session*

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for an associated data collaboration terminal [is done] using an audio communication terminal, the Cruickshank reference teaches "determining the IP addresses of computers associated with the calling station and called station, and causing the computers of the called and calling stations to establish a data-only collaboration." Although both the present application and the Cruickshank reference related to voice and data collaboration, claim 1 covers a completely different invention from the one taught or suggested in the Cruickshank reference. Cruickshank actually teaches away from the limitations claimed in independent claims 1, 25 and 53.

These defects are not cured by the teachings of the secondary reference, Thomson, which teaches:

"A collaborative computer telephony system, comprising a communication network; a plurality of integrated computer telephony devices connected to the network and identified by unique IP addresses, at least two of the integrated computer telephony devices supporting collaboration application programs; an indicator on at least one of the integrated computer telephony devices; and a collaborate control program associated with each of the integrated computer telephony devices for detecting commonly supported ones of the collaboration application programs and in response activating the indicator." (Abstract of Thomson).

Thomson teaches an integrated computer telephony device capable of supporting both voice and data sessions, whereas independent claims 1, 25 and 53 are directed towards separate and associated voice and data collaboration terminals, where the voice terminals may be used to initiate a data collaboration session between parties engaged in a voice communication session. Nowhere in the Thomson reference does it mention using a voice terminal to initiate a data collaboration session on a separate data collaboration terminal.

Applicant respectfully asserts that the Examiner failed to show any suggestion or motivation to combine the teachings of the cited references at the time of the invention. Applicant submits that, at least at the time the invention was made, the teachings of the primary reference could not be considered to be analogous to what is taught in the secondary reference, and therefore do not suggest a possible motivation to combine the two references. Applicant asserts that the Examiner used impermissible hindsight to try to reconstruct the Applicant's invention by using the Applicant's structure as a template and selecting elements from the references to fill the gaps (see *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991)). Applicant notes that

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for the purpose of considering whether a suggested combination may be used to establish implicit teaching, motivation, or suggestion, the references to be combined must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination.

“[T]he test for establishing an implicit teaching, motivation, or suggestion is what the combination of these two statements of Evans would have suggested to those of ordinary skill in the art, the two statements cannot be viewed in the abstract...Rather, they must be considered in the context of the teaching of the entire reference.” *In re Kotzab*, 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000)

Applicant respectfully asserts that an adequate consideration of the prior art cited by the Examiner as a whole, could not have been used to establish sufficient implicit teaching, motivation, or suggestion of the present invention. Furthermore, even if the Examiner had shown motivation to combine the two cited references, the combination would not have covered all the limitations of the present invention.

Accordingly, the Applicant asserts that the Examiner has failed to establish a prima facie case of obviousness and respectfully request withdrawal of the 103 rejections of claims 1, 25 and 53. Applicant therefore respectfully requests allowance of independent claims 1, 25 and 53, and allowance of all dependent claims depending there-from.

In the Office Action, the Examiner rejected claims 32-36, 37-41, 42-44, 45-50 under 35 U.S.C. § 103(a), as being unpatentable over Thomson et al. (US 2001/0056466A1, filed 12-19-2000) in view of Fostick (US PAT: 6,856,809, filed 5-17-2001).

Applicant respectfully traverses the rejection of claims by Thomson et al. (US 2001/0056466A1, filed 12-19-2000) under Fostick (US PAT: 6,856,809, filed 5-17-2001). Applicant respectfully asserts that the Examiner failed to establish a prima facie case of obviousness, by failing to show motivation to combine the teachings of the two references. Furthermore, even if the Examiner had shown motivation to combine the two cited

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references, the combination would not have covered all the limitations of the present invention.

Claim 32 of the present invention teaches:

"A system comprising: an SMS server; a server; and *an Internet location server in communication with the SMS server and the server*; wherein when the Internet location server receives signals from the SMS server indicating that an audio session is taking place among a plurality of endpoints, *the Internet location server transmits a signal to the server, and the server, upon receipt of the signal, initiates a data collaboration session between the plurality of endpoints.*"

Thomson, the primary reference states:

"A collaborative computer telephony system, comprising a communication network; a plurality of integrated computer telephony devices connected to the network and identified by unique IP addresses, at least two of the integrated computer telephony devices supporting collaboration application programs; an indicator on at least one of the integrated computer telephony devices; and a collaborate control program associated with each of the integrated computer telephony devices for detecting commonly supported ones of the collaboration application programs and in response activating the indicator." (Abstract of Thomson).

Fostick, the secondary reference states:

A method, computer system, computer program product, and user interface for enabling SMS users to engage in many-to-many conversation, or an SMS conference, utilizing SMS services. Specifically, a user initiates an SMS conference by sending a short message, including the contact numbers for a group of conference participants, to a control center. The control center establishes an SMS conference by storing the contact information as a conference group and assigning a unique identifier to the conference group. Thus, the SMSC establishes an SMS conference by associating the conference group with a unique identifier. The SMSC transmits the short message from the conference initiator to each participant. A participant is able to send a message to all conference participants by addressing the message to the unique identifier. The control center then forwards the message

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to each participant in the conference as indicated by the unique identifier. (Abstract of Fostick).

In view of the above excerpts from the present Application and the cited references, the Applicant respectfully asserts that the Examiner failed to show a suggestion or motivation to combine the teachings of the two cited references at the time of the invention. Applicant submits that, at least at the time the invention was made, the teachings of the primary reference could not be considered to be analogous to what is taught in the secondary reference, and therefore do not suggest a possible motivation to combine the two references.

Since the first reference relates to voice and data communications, while the second relates to cellular text messaging, both technologies only related by the fact they involve communication, Applicant asserts that the Examiner used impermissible hindsight to try to reconstruct the Applicant's invention by using the Applicant's structure as a template and selecting elements from the references to fill the gaps (see *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991)). Applicant notes that for the purpose of considering whether a suggested combination may be used to establish implicit teaching, motivation, or suggestion, the references to be combined must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination.

Applicant respectfully asserts that an adequate consideration of the prior art cited by the Examiner as a whole, could not have been used to establish sufficient implicit teaching, motivation, or suggestion of the present invention. Furthermore, even if the Examiner had shown motivation to combine the two cited references, the combination would not have covered all the limitations of the present invention. More specifically, the secondary reference discuss initiating sms conference using an sms. Whereas claim 32 recites: "*the Internet location server transmits a signal to the server, and the server, upon receipt of the signal, initiates a data collaboration session between the plurality of endpoints.*" This limitation is nether taught nor suggested by either reference. The combination of an the integrated voice/data terminal in the primary reference with the SMS conferring system of the second reference, even if proper, does not provide for all the limitations of claim 32. Furthermore, even if the Examiner had shown motivation to combine the two cited references, the combination would not have covered all the limitations of the present invention.

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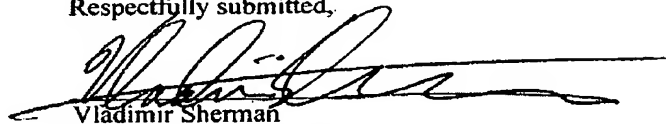
Accordingly, the Applicant requests allowance of claim 32 and all the claims which depend there-from.

In the Office Action, the Examiner rejected claims 5, 22 under 35 U.S.C. § 103(a), as being unpatentable over Cruickshank in view of Thomson as applied to claim 1 above, and further in view of Sullivan (US PAT: 5,351,296). In addition, the Examiner rejected claims 6, 23, 31, 56 under 35 U.S.C. § 103(a), as being unpatentable over Cruickshank in view of Thomson as applied to claims 1, 25, 53 above, and further in view of Fostick; as well as claims 10 and 20 under 35 U.S.C. § 103(a), as being unpatentable over Cruickshank in view of Thomson as applied to claim 1 above, and further in view of Kerr (US PAT: 5,844,600). Finally, the Examiner rejected claims 10 and 20 under 35 U.S.C. § 103(a), as being unpatentable over Cruickshank in view of Thomson as applied to claim 1 above, and further in view of Hinderks (US PAT: 6,700,958, filed 7-3-2001).

For the same reasons as stated above for independent claims 1, 25, 32, 45 and 53, Applicant respectfully requests reconsideration and withdrawal of the rejections of these claims. Furthermore, since independent claims 1, 25, 32, 45 and 53 should be allowable, the above listed dependent claims should be allowable by virtue of their dependence on allowable base claims.

In view of the foregoing remarks, the pending claims are considered to be allowable. Their favorable reconsideration and allowance is respectfully requested.

Respectfully submitted,



Vladimir Sherman
Attorney for Applicant(s)
Registration No. 43,116

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